

REMARKS

Claims 1-39 were pending and presented for examination and in this application. In an Office Action dated April 28, 2009, claims 1-9, 11-14, 16-18, 20-34 and 36-39 were rejected. Applicants thank the Examiner for examination of the claims pending in this application and address the Examiner's comments below. Based on the above Amendment and the following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections, and withdraw them.

Response to Rejection under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejects claims 1 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Aratani, U.S. Patent No. 7,260,828 in view of Hoda, U.S. Patent No. 4,831,610. The Examiner rejects claims 2-19 and 21-39 as being unpatentable over Aratani in view of Hoda in further view of Hoffberg, U.S. Patent No. 6,400, 996. This rejection is traversed in view of the amended claims.

Amended claim 1¹ recites a printer for generating media representations of a collection of media programs received from a media receiver, the printer comprising:

- a print drive interface for receiving scheduling preferences comprising a media program;
- a control module for setting the media receiver to a channel that includes media program scheduling information;
- an extraction module for extracting, from the channel, scheduling information associated with the media program;
- a processing logic for generating a list of scheduled play times of the media program based on the extracted scheduling information;
- a print engine for printing the list of scheduled play times of the media program, the list comprising one or more user selectable barcodes for each play time of the media program, wherein each barcode is

¹ Note that the amendment to claim 1 does not substantively change the claim. Applicants merely made clarifications to the "print engine" of claim 1 by moving language that previously was recited in the limitation related to the "processing logic." Thus, an updated search is not required in view of the amendment to claim 1.

associated with an action that is performed by the printer responsive to user selection of the barcode; and a media transfer interface for permitting communication between the printer and the media receiver, the media transfer interface being coupled to the media receiver.

These aspects of the claimed invention are not disclosed or suggested by Aratani. Specifically, Aratani does not disclose or suggest the claimed “printer” since Aratani fails to disclose or suggest a single apparatus that comprises the elements recited in the claimed invention, such as “a print engine for printing the list of scheduled play times of the media program, the list comprising one or more user selectable barcodes for each play time of the media program, wherein each barcode is associated with an action that **is performed by the printer** responsive to user selection of the barcode.”

Aratani discloses a digital TV broadcast receiving apparatus. *See* Aratani, col. 3, ll. 2-4; Figure 1, element 100. Aratani’s apparatus receives electronic programming guide (EPG) data and a search is performed on the EPG data for a particular program designated by a user. *See* Aratani, col. 10, ll. 1-12. Once the program is located, Aratani discloses that an action code list is then printed. *See* Aratani, col. 10, ll. 31-34. The Examiner suggest that Aratani’s apparatus could be a corollary to the claimed “printer” that comprises “a print engine for printing the list of scheduled play times of the media program...” and that the action code list could be a corollary to the “list of scheduled play times.”

Assuming *arguendo* that the action code list could be considered the claimed “list of scheduled play times of the media program,” the action code list is still not **printed** by Aratani’s apparatus as claimed. Rather, Aratani discloses that the action code list is printed by a printer that is externally connected to the apparatus via an IEEE1394 interface. *See* Aratani, col. 4, ll. 65-67 through col. 5, ll. 1-4; col., 10, ll. 26-34; Fig. 1. Thus, Aratani’s

apparatus does not comprise the necessary elements to print the action code list and instead relies on the external printer to print the action code list. In contrast, in the claimed invention, the printer comprises “a print engine for printing the list of scheduled play times of the media program...” For at least this reason, Aratani does not disclose or suggest the claimed “printer.”

However, there are additional bases upon which the claimed invention is patentable in view of Aratani. Even assuming *arguendo* that Aratani’s apparatus did in fact print the action code list, since the action code list does not comprise “one or more barcodes” as admitted by the Examiner, the printed action code list does not comprise “one or more user selectable barcodes for each play time of the media program, wherein each barcode is associated with an action that is performed by the printer responsive to user selection of the barcode.” Thus, Aratani does not disclose or suggest the claimed “list of scheduled play times of the media program.”

Even assuming *arguendo* that an action code in the action code list could be a corollary to the claimed “one or more barcodes,” there is no hint, mention, or suggestion in Aratani that each action code “is associated with an action that is performed...**responsive to user selection of [a] barcode**” from the printed action code list, as claimed. At best, Aratani states that each action code in the printed action code list is associated with an action function that is executed when the action code is input by the user via a 10 key pad in the remote control unit shown in FIG. 2. *See also* Aratani, col. 6, ll. 51-53. Thus, in Aratani when a user finds a program of interest in the printed action code list, the user selects an action code associated with the program of interest *by pressing a sequence of numbers on the 10 key pad that corresponds to the action code* for transmittal to the apparatus. Therefore, in

Aratani an action is performed responsive to entering an action code via the remote control because an action code cannot be “selected” directly from the action code list. In contrast, in the claimed invention an action is performed “responsive to user selection of the barcode” **from the printed list** of scheduled play times of the media program.

Hoda does not remedy the deficiencies of Aratani. There is no hint, mention, or suggestion in Hoda of a printer comprising “a print engine for printing the list of scheduled play times of the media program...” nor does the Examiner make this assertion. The Examiner merely applied Hoda to disclose the concept of barcodes. At best, Hoda discloses a method and apparatus for controlling a visual data playback apparatus such as a video disc player. *See* Hoda, Abstract. Hoda states that a guidebook which describes various animals may have an associated video disk that comprises moving picture data items relating to different sections of the text of the guidebook. *See* Hoda, col. 4, ll. 60-68. By selecting a barcode on the guidebook an associated image is then displayed.

The combination of Aratani and Hoda still does not disclose or suggest “a printer” comprising “a print engine for printing the list of scheduled play times of the media program, the list comprising one or more user selectable barcodes for each play time of the media program, wherein each barcode is associated with an action that is performed by the printer responsive to user selection of the barcode.” This rejection is a classic example of hindsight reconstruction: the Examiner has seen the disclosed embodiments of the claimed invention as illustrated in the Applicants’ drawings and in the Applicants’ specification and has searched the prior art for the individual ones of recited features of claim 1. The Examiner relied upon a piece meal approach using elements from Aratani and Hoda to individually disclose the recited features. Here, the Examiner relied upon Aratani to disclose the claimed “printer”

and relied upon Hoda to disclose the “barcode” feature. However, none of these references individually show the combination of “a printer” with the recited features. Nor do any of the references suggest that it could be combined with other teachings of the specifically claimed elements. Thus, the combination articulated by the Examiner appears to be based on improper hindsight reasoning that impermissibly relies upon Applicants’ own disclosure to find such motivation. See *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971); MPEP 2145.

Furthermore, as mentioned above, the Examiner admits that Aratani does not disclose or suggest that the action code list comprises “one or more selectable barcodes.” See Office Action, p. 6. Because Aratani does not disclose or suggest this feature, Aratani provides no “established” mechanism by which to incorporate the barcodes of Hoda into the apparatus of Aratani. As a result, the combination of the references would inherently fail to operate in the claimed manner, thus precluding the “predictability” of the Examiner’s combination of the cited references to disclose the recited features of claim 1. The suggested combination thus would take the cited aspects of Aratani beyond its “established functions,” precluding the “predictability” of such a combination of references. Thus, the claimed invention is “more than a predictable use of [these] prior art elements according to their established functions.” See *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

Thus, the cited references fail to show all of the claimed elements and therefore the Examiner has not met his burden in establishing a prima facie case of obviousness under 35 U.S.C. § 103(a). Claim 1 is patentably distinguishable over the cited references both alone and in combination.

Claim 20 has been amended to include similar limitations to those of claim 1. The Examiner rejected claim 20 for the same reasons set forth in the rejection of claim 1. Thus, all arguments advanced above with respect to claim 1 are hereby incorporated so as to apply to claim 20. Thus, claim 20 also is patentably distinguishable over the cited references both alone and in combination for the reasons discussed above.

The obviousness rejection of claims 2-9, 11-14, 16-18, 21-34, and 36-39 applied Aratani in various combinations with other references including Hoda and Hoffberg only for the dependent limitations in the claims. Hoffberg does not remedy the deficiencies of the cited references described above, nor does the Examiner argue that it does. Claims 2-9, 11-14, 16-18, 21-34, and 36-39 incorporate the limitations of their respective base claims. Applicants submit that claims 2-9, 11-14, 16-18, 21-34, and 36-39 are allowable for at least the reasons described above, in addition to the further patentable limitations recited therein.

As noted in the footnote above, the amendment to the claims herein merely **moved** a limitation from one element to the next for clarity. The Examiner focused on the process performed by the claimed elements of claim 1 in the rejection of that claim rather than the recited structures. Thus, the amendment does not alter the claim in a way that would necessitate a new search, should the Examiner not deem the claims allowable upon next action. *See* MPEP 714.13.

Conclusion

In sum, Applicants respectfully submit that claims 1-9, 11-14, 16-18, 20-34, and 36-39 as presented herein, are patentably distinguishable over the cited references. Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them.

In addition, Applicants respectfully invite the Examiner to contact Applicants' representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,

Dated: June 24, 2009

By: /Jennifer R. Bush/
Attorney for Assignee
Jennifer R. Bush, Reg. No. 50,784
FENWICK & WEST LLP
801 California Street
Mountain View, CA 94041
Phone: (650) 335-7213
Fax: (650) 938-5200